

Serial No. 10/667,266
Atty. Doc. No. 2002P02639WOUS

REMARKS

Claims 7-14, 23 and 25 are pending in this application. Claims 7-14, 23 and 25 stand rejected under 35 USC 112, second paragraph, as being indefinite due to the inadvertent removal of a semicolon. Claims 7, 10-14, 23 and 25 stand rejected under 35 USC 103(a) as being unpatentable over Elam in view of Armstrong. Claim 8 stands rejected under 35 USC 103(a) as being unpatentable over Elam in view of Armstrong and further in view of Rigney. Claim 9 stands rejected under 35 USC 103(a) as being unpatentable over Elam in view of Armstrong and further in view of Foster.

Response to Rejections under Section 112:

Claim 7 has been amended herein to reinsert the missing semicolon. The word "of" after the word "coating" has also been removed in accordance with the Examiner's suggestion. These amendments overcome the rejection of the claims under 35 USC 112.

Response to Rejections under Section 103:

Claim 7 has been amended herein to include the limitation of a layer of ceramic powder consisting essentially of a zirconium oxide powder. Note that this limitation is derived from claim 10, and claim 10 has been cancelled herein.

In the rejection of claim 10, the Examiner states that Elam discloses that the maskant may include any amount of zirconium oxide and that this would include an amount that would make the powder consist essentially of zirconium oxide (citing column 3, lines 38-45 of Elam). The Examiner acknowledges that this would require providing the zirconium oxide maskant without the inhibitor, and the Examiner argues that "it would have been obvious to provide the zirconium oxide maskant without the inhibitor because it is well settled that omission of an element and its function is obvious if the function is not necessary."

The present applicants argue that Elam on its face teaches away from eliminating the inhibitor. At column 3, lines 47 to column 4, line 2, Elam states that the maskant should contain an inhibitor, with the quantity of inhibitor ranging from a minimum amount of about 5% up to 95% of the solids portion. Elam teaches that the function of the inhibitor is needed in order to

Serial No. 10/667,266
Atty. Doc. No. 2002P02639WOUS

prevent the masked area from expanding to a surface area beyond the original masked boundaries due to volumetric change of the maskant. Thus, not only does Elam teach the inclusion of the inhibitor, he also provides motivation against the deletion of the inhibitor, thereby rendering it not obvious to modify Elam's maskant to arrive at the present invention.


Conclusion

For the foregoing reasons, it is respectfully requested that the Examiner enter this amendment and reconsider the allowance of the amended application.

Please grant any extensions of time required to enter this paper. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated: 4/6/06

By: 
John P. Musone
Registration No. 44,961
(407) 736-6449

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830